

Application No.: 10/657859

Case No.: 58878US002

Remarks**102 Rejections**

Claims 1-11 stand rejected under 35 USC § 102(b) as being anticipated by Prix (WO 98/52733).

Claim 1 is directed to an apparatus for casting a patterned surface on both sides of a web. Claim 1 requires that the apparatus creates the patterns such that said patterns are maintained in continuous registration on the opposite sides of the web to within 100 microns. Claims 2-11 depend from independent claim 1 and all have the same requirement.

The claims stand rejected on the basis that the patterned rollers of the Prix reference are “conceivably and inherently capable to one skilled in the art to transferring patterns to opposite sides of the film from within 100 to 5 microns.” (Page 4 of Office Action)

It is Applicant’s position that the rejection of claims 1-11, as given, is not a proper 102(b) rejection. First, “conceivably” is not a proper legal basis for a novelty rejection. Second, it is also applicant’s position that the statement that the patterned rollers of the Prix reference are “inherently capable of” transferring patterns to opposite sides of the film from within 100 500 μ is not supported by sufficient evidence in the specification.

As a preliminary matter, for fact to be inherent in a reference, the Examiner must provide rationale or evidence tending to show inherency. MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that characteristic or result. Therefore, the rejection that the Prix reference “conceivably” is capable to one of skill the art of transferring patterns opposite sides of the film from within 100 to 5 microns is not a proper rejection.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described (in the reference) and that it would be so recognized by persons of ordinary skill. Inherency however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberts*, 169 F3d 43, 45 (Federal Circuit 1999). Applicants submit that there is nothing present in the Prix reference to establish that the degree of registration is necessarily present. Also, Applicants submit that the Prix reference does not enable one skilled in the art to practice the invention of the presently pending claims.

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"In relying upon theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Board Of Patent Appeals And Interferences 1990).

It is Applicant's position that the rejection as given in the Office Action does not provide a basis in fact or technical reasoning to reasonably support the assertion that the allegedly inherent characteristic (registration within the claimed range) necessarily flows from the teaching of the Prix reference.

Because the rejection, as made, does not provide a basis in fact and/or technical reasoning to reasonably support the determination that the patterned rollers (of Prix) are capable of registering patterns on opposite sides of a web continuously to within 100 microns, as required by claims 1-11, it cannot be said that this characteristic necessarily flows from the Prix reference.

In light of the forgoing reasons, rejection of claims 1-11 under 35 USC § 102(b) as being anticipated by Prix (WO 98/52733) has been overcome and should be withdrawn.

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Applicants have elected Group I (claims 1-11). Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required; please charge the fee to Deposit Account No. 13-3723. If it would help advance prosecution of this case, the Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

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Date

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